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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/808,315	02/28/1997	HIROYUKI KINOSHITA	247/PD-5385	6175

7590

12/18/2002

JOHN P. SCHERLACHER, ESQ.
HOGAN & HARTSON, L.L.P
500 SOUTH GRAND AVENUE, SUITE 1900
BILTMORE TOWER
LOS ANGELES, CA 90071

EXAMINER

MENEFEE, JAMES A

ART UNIT

PAPER NUMBER

2828

DATE MAILED: 12/18/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/808,315

Applicant(s)

KINOSHITA ET AL.

Examiner

James A. Menefee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 October 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17,20 and 21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 17,20 and 21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Paul IP

PAUL IP

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Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Response to Amendment

In response to the amendment filed 18 October 2002, claim 20 is amended. Claims 17 and 20-21 are pending.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 17 and 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Regler et al. (previously cited US 4,161,167). Regler discloses the claimed invention as follows:

Regler discloses lap cutting blades for cutting a substances such as sapphire or rubies. The sapphire body is inherently a sapphire monocrystal plate. A sapphire monocrystal plate will inherently comprise a major face, and a working reference plane on a peripheral edge of the plate. A sapphire monocrystal inherently comprises a plane R that is known as a cleavage plane of a sapphire monocrystal plate. As the plane R is known as the cleavage plane of a sapphire monocrystal plate, then when the plate is originally formed, a peripheral edge of the plate will be formed substantially parallel to the cleavage plane R. When the lap cutting blades cut the sapphire monocrystal plate, they inherently will do so on a cleavage plane of the plate, thus the microcrack line on the major face will be parallel to the cleavage plane R. The cleavage plane R of a sapphire monocrystal plate is known to be at about 57 degrees, which applicant has

disclosed to be less than about 70 degrees. This will form a sharp edge when the cleavage takes place.

Claims 17 and 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Kato et al. (previously cited US 4,662,124). Kato discloses the claimed invention as follows:

Kato shows in figures 3 and 10 a sapphire monocrystal plate having a major face, an R plane and C planes with an inclination angle less than about 70 degrees as required by the claims. While Kato discloses grinding of this plate, this is a known sapphire monocrystal plate with a known cleavage plane R. Such a plate inherently may be cleaved along the cleavage planes, forming the device as claimed.

Response to Arguments

The arguments concerning the 35 USC 112 rejection are persuasive and the rejection has been withdrawn.

Regarding the arguments concerning Regler, the arguments are mostly drawn to the lap cutting blades. The rejection is not concerned with these blades, they are concerned with a sapphire plate that the blades are shown to be used to cut. A sapphire plate will inherently have the claimed limitations as shown in the above rejections.

Regarding the arguments concerning Kato, while the sapphire plate of Kato is not explicitly disclosed to include the limitations as claimed, the sapphire plate will inherently possess the claimed planes as shown above.

It should be noted that the limitations that the applicant believes are important to the patentability of the device, i.e. the noted planes and relationships therebetween, will inherently

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be possessed by any sapphire monocrystal plate having a cleavage R plane as shown in Kato.

Many sapphire monocrystal plates have such a plane.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Menefee whose telephone number is (703) 605-4367. The examiner can normally be reached on M-F 8:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Ip can be reached on (703) 308-3098. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.


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December 3, 2002